

Serial Number: 09/717,553  
Attorney Docket N.: 09824.105002  
Page 6

#### **REMARKS**

The Applicants and the undersigned thank Examiner Loney for his careful review of this application. Consideration of the present application is respectfully requested in light of the above amendments to the claims, and in view of the following remarks. Claims 1, 2, 4-13, 16-18 and 20 have been rejected and Claim 19 has been objected to. Upon entry of this amendment, Claims 1, 2, 4-13, and 16-20 remain pending in this application.

#### **Amendments to Claims 2, 7, and 18-20 to Correct Informalities**

Applicants have amended Claims 2, 7, and 18-20 to correct informalities and to ensure proper antecedent basis for recited terms. These amendments were not made to distinguish the recited invention from the prior art or to address substantive issues of patentability.

#### **CLAIM REJECTIONS UNDER 35 U.S.C. § 112 ¶ 2**

The Examiner rejected Claim 5 under 35 U.S.C. § 112 ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More specifically, Examiner rejected Claim 5 for reciting "a third layer" when a second layer has not been established. Applicants have amended Claim 5 to address this rejection of form. Accordingly, Applicants respectfully request the withdrawal of Examiner's § 112 rejection of Claim 5.

#### **CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b)**

The Examiner rejected Claims 1, 4, 6, 7, 16, 17, and 20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,681,865 to Heine. The Examiner rejected Claims 1, 2, 4,

Serial Number: 09/717,553  
Attorney Docket No.: 09824.10500  
Page 7

16, and 17 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,512,310 to Corson. The Examiner rejected Claims 1, 2, 4, 6, 8, 13, 16-18, and 20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,217,821 to Shiner. The Examiner rejected Claims 1, 2, 5, 6, 8, 16, and 17 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,622,260 to Tesch.

Claim 1

It is respectfully submitted that the *Heine*, *Corson*, *Shiner*, and *Tesch* references fail to describe, teach, or suggest the recitations of amended independent Claim 1 for at least the reasons provided in the following discussion.

**The *Heine* Reference Fails to Describe or Suggest Each and Every Recitation of Amended Independent Claim 1**

Applicants respectfully submit that the *Heine* reference fails to teach or suggest all of the recitations enumerated in independent Claim 1 as currently amended. Claim 1 recites a mat for use on a substantially flat floor surface comprising: at least one layer of a material having a bottom surface and a top surface; wherein the bottom surface has at least one recession therein, the recession having an opening; wherein the recession is operative to reduce movement of the layer when the opening is in contact with the floor surface; and wherein at least a portion of the recession is cylindrical. Applicants submit that *Heine* fails to teach or suggest a mat having a cylindrical recession operative to reduce movement. *Heine* teaches the "boring of holes in the material" so that "sound absorption properties can be further increased. (*Heine*, col. 1, lines 11-15). Thus, in *Heine* the holes are not operative to reduce movement of a layer of material. Indeed, the materials described in the *Heine* reference are ceramic tile materials that cannot be

deformed to increase the static friction with a floor surface by creating a suction effect.

Applicants further submit that *Heine* fails to teach or suggest a layer having a recession, wherein at least a portion of the recession is cylindrical. As stated above, *Heine* teaches the boring of holes in a ceramic material. Once the holes are bored on the unglazed portion of a ceramic tile, a glazing composition is applied to the unglazed portion of the tile, including the bored holes. (*Heine*, col. 2, lines 52-55). By adding glazing material to the bored holes and allowing it to harden, the holes will be filled with the glazing material so that no portion of the un-filled portion of the hole will be cylindrical. (*Heine*, col. 2, lines 48-55). Thus, the *Heine* patent fails to teach or suggest each of the recitations of amended Claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of independent Claim 1 as being anticipated by *Heine*.

**The *Corson* Reference Fails to Describe or Suggest Each and Every Recitation of Amended Independent Claim 1**

Applicants respectfully submit that the *Corson* reference fails to teach or suggest all of the recitations of independent Claim 1 as amended. Claim 1 recites a mat for use on a substantially flat floor surface comprising: at least one layer of a material having a bottom surface and a top surface; wherein the bottom surface has at least one recession therein, the recession having an opening; wherein the recession is operative to reduce movement of the layer when the opening is in contact with the floor surface; and wherein at least a portion of the recession is cylindrical. Applicants submit that *Corson* fails to teach or suggest a layer having a recession, wherein at least a portion of the recession is cylindrical, as recited in amended Claim 1. *Corson* teaches a pad having a series of projections in which "the bottom faces of the projections 18 may be recessed as indicated at 18a." (*Corson*, col. 2, lines 25-30). However, the

Serial Number: 09/717,553  
Attorney Docket No.: 09824.10500  
Page 9

recessions in *Corson* are substantially cube-shaped, and no portion of the recession is cylindrical (See *Corson* Fig. 5).

The Examiner directs Applicants' attention to Figures 8 and 9 as well as column 2, lines 43-47 of *Corson*. The Examiner used these excerpts to support the contention that *Corson* teaches cylindrical recessions. Applicants respectfully submit that Examiner has misinterpreted those figures. Figure 8 of *Corson* is a variation of Figure 5, substituting round recesses for the square recesses depicted in Figure 5. (*Corson* col. 2, lines 43-46). The round recesses 17a replace the square recesses 17 which are "in the upper face [of the mat]." (*Corson*, col. 2, lines 23-26, 45-46). The projections on the underside of the mat 18a in Figure 8 replace the integral projections 18 of Figure 5. (*Corson*, col. 2, lines 26, 45-47). *Corson* clearly states that "these projections 18a are solid rather than recessed." (*Corson*, col. 2, lines 45-48). Thus, *Corson* teaches cube-shaped recesses and cylindrical projections. However, *Corson* specifically teaches away from a bottom surface having a recession wherein at least a portion of the recession is cylindrical as recited in amended Claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of independent Claim 1 as being anticipated by *Corson*.

**The *Tesch* Reference Fails to Describe or Suggest Each and Every Recitation of Amended Independent Claim 1**

Applicants respectfully submit that the *Tesch* reference fails to teach or suggest all of the recitations of independent Claim 1, as amended. Claim 1 recites a mat for use on a substantially flat floor surface comprising: at least one layer of a material having a bottom surface and a top surface; wherein the bottom surface has at least one recession therein, the recession having an opening; wherein the recession is operative to reduce movement of the layer when the opening is

in contact with the floor surface; and wherein at least a portion of the recession is cylindrical. Specifically, Applicants submit that *Tesch* fails to teach or suggest a bottom surface having a recession, wherein at least a portion of the recession is cylindrical. Applicants submit that *Tesch* also fails to teach or suggest a mat with a substantially cylindrical recession, wherein the substantially cylindrical recession has an opening and is operative to reduce movement of the layer when the opening is in contact with the floor surface.

The Examiner initially directs Applicants' attention to Figure 2 of *Tesch* to support the Examiner's assertion that *Tesch* teaches a mat with a backing layer having a cylindrical recession therein. Applicants respectfully submit that the Examiner has misconstrued Figure 2 of *Tesch*. *Tesch* teaches the creation of depressions 8 by deep drawing of a thermoplastic sheet. The depressions are in the shape of bowls and are made into the top side of the backing layer. (*Tesch*, col. 6, lines 58-63, and Figure 2). *Tesch* further states that "the depressions 8 are opening toward the cover layer 2, so that particles may be inserted in the depressions [8]." (*Tesch*, col. 6, lines 66-69) Therefore, the recessions of *Tesch* are made in the top surface of the layer and not in the bottom surface as recited in amended Claim 1. Moreover, the *Tesch* recessions are full of particles and cannot be operative to reduce movement of the mat. The bowl shaped depressions of *Tesch* are filled with "a layer of granular particles 6 consist[ing] of rock particles of a small grain size." (*Tesch*, col. 6, lines 11-12). Since the bowl-shaped depressions of *Tesch* are filled with particles, the depressions are not operative to reduce movement of the mat when the opening of the depression is in contact with the floor surface.

It is also possible that the Examiner is suggesting that in viewing Figure 2 of *Tesch*, the areas between the depressions 8 on the bottom surface of the bottom layer are cylindrical. At first it does appear that the areas between the depressions 8 are cylindrical. However, this is an

Serial Number: 09/717,553  
Attorney Docket No.: 09824.105002  
Page 11

optical illusion caused by a cross-section view of the *Tesch* embodiment. As stated earlier, *Tesch* teaches depressions in the shape of bowls in the top-side of the backing layer. Thus, these depressions must be circular. Since the depressions in the top layer are circular, there is no pattern of depressions made in the top-side of the backing layer which could create a recession in the bottom layer, wherein a portion of the recession is cylindrical. Thus, Figure 2 of *Tesch* does not teach or suggest a bottom surface having a recession, wherein at least a portion of the recession is cylindrical.

Next, Examiner directs Applicants' attention to column 9, lines 14-16 of *Tesch* for the assertion that *Tesch* teaches a backing layer having a cylindrical recession therein. *Tesch* teaches a layer "with cylindrical depressions (nubs) ... used as the backing sheet 3. The nubs were filled level with quartz sand and covered." (*Tesch*, col. 9, lines 14-16) (emphasis added). The backing layer was then covered with a layer of fiber. If the nubs were filled, then the nubs must have been made in the top-side of backing layer. Attempting to fill recessions in the bottom side would not be possible. Furthermore, the section cited by Examiner directs the reader's attention to Figure 2. As shown above, Figure 2 fails to teach or suggest a substantially cylindrical recession in the bottom layer.

Applicants further submit that *Tesch* fails to teach or suggest a recession having an opening, said opening being in contact with the floor surface. Specifically, *Tesch* teaches a cover layer and holding fibers covering the bowl-shaped depressions. (*Tesch*, col. 7, lines 3-13). Because an intermediate layer of material is located between the opening and any surface, the opening of the depressions in *Tesch* cannot be in contact with a floor surface as recited in amended Claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of independent Claim 1 as being anticipated by *Tesch*.

**The *Shiner* Reference Fails to Describe or Suggest Each and Every Recitation of Amended Independent Claim 1**

Applicants respectfully submit that the *Shiner* reference fails to teach or suggest all of the recitations of independent Claim 1, as amended. Claim 1 recites a mat for use on a substantially flat floor surface comprising: at least one layer of a material having a bottom surface and a top surface; wherein the bottom surface has at least one recession therein, the recession having an opening; wherein the recession is operative to reduce movement of the layer when the opening is in contact with the floor surface; and wherein at least a portion of the recession is cylindrical. *Shiner* fails to teach or suggest a bottom layer of material having a recession, wherein at least a portion of the recession is cylindrical.

*Shiner* teaches covering both sides of a metal sheet with sheets of flexible material. (*Shiner*, col. 1, lines 53-55). The metal sheet contains perforations. When the metal sheet is covered with the two sheets of flexible material, one on each side of the metal sheet, the two sheets of flexible material "contact each other and are cemented together" at the perforations. (*Shiner*, col. 2, lines 10-15, Figures 1 and 2). As shown in Fig. 2 of *Shiner*, when the two sheets of flexible material are cemented together they create a truncated cone, and not a recession wherein a portion of the recession is cylindrical. (*Shiner*, Fig. 2).

*Shiner* teaches only that the flexible materials contact each other at the perforations, not that the flexible material contacts the sides of the perforations so that a portion of the recession would be cylindrical. The flexible material on each side of the metal sheet does not adhere to the sides of the perforations made in the metal sheet. *Shiner* does not teach that any portion of the recession is cylindrical, thereby failing to teach all of the recitations enumerated in amended

Serial Number: 09/717,553  
Attorney Docket No.: 09824.105002  
Page 13

Claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection of independent Claim 1 as being anticipated by *Shiner*.

Claims 2, 4-8, 13, 16-18, and 20

The Applicants respectfully submit that dependent Claims 2, 4-8, 13, 16-18, and 20 are allowable because the independent claim from which they depend (Claim 1) is patentable over the cited references. The Applicants also respectfully submit that the recitations of these dependent claims are of patentable significance. In view of the foregoing, the Applicants respectfully request that the Examiner withdraw the pending rejections of Claims 2, 4-8, 13, 16-18, and 20.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)

The Examiner rejected Claims 9-12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,217,821 to *Shiner* or U.S. Patent No. 4,622,260 to *Tesch*. The Applicants respectfully offer the following remarks to traverse these pending rejections.

Dependent Claims 9-12 are Distinguishable from the *Shiner* and *Tesch* Patents

**The Examiner has Failed to Provide Factual Support for a *Prima Facie* Conclusion of Obviousness**

The rejection of amended dependent Claim 9 and dependent Claims 10-12 is respectfully traversed. The Examiner claims that it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify *Shiner* or *Tesch* to create multi-layer mat where each layer can have a different variety of rubber having different flexibilities, said mat also having layers with differing durometer levels. It is respectfully submitted that the Examiner has

Serial Number: 09/717,553  
Attorney Docket No.: 09824.105002  
Page 14

failed to carry the Examiner's burden of demonstrating *prima facie* obviousness under Section 103. MPEP § 2142 paragraph 1 (8<sup>th</sup> Edition, August 2001), states the following:

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

Applicants respectfully submit that the Examiner has failed to provide a proper rationale or motivation for one of skill in the art at the time of the invention to modify *Shiner* or *Tesch* to achieve the invention recited by Claims 9-12. Moreover, it is respectfully submitted that the Examiner has failed to support an obviousness rejection of Claims 9-12 by identifying a teaching in the prior art suggesting a modification to *Shiner* or *Tesch* to include a multi-layer mat wherein each layer "consists of a different variety of rubber having varying flexibilities" and a multi-layer mat where the "bottom layer consists of a rubber compound having a lower durometer reading than said top layer."

Neither *Shiner* nor *Tesch* teach or suggest layers or mats having varying levels of hardness. The Examiner has admitted that both *Shiner* and *Tesch* "fail to teach the variety of rubbers and two different hardnesses." (Official Action, p. 3, line 22). The Examiner has also failed to show any motivation in *Shiner* or *Tesch* for a mat or layers having varying levels of hardness. Therefore, the Examiner has failed to show any reference for a mat or layers having varying levels of hardness or any motivation in the cited references to create a mat or layers having varying levels of hardness.

Furthermore, as shown above in the traversal of rejections for anticipation, both *Shiner* and *Tesch* fail to teach or suggest elements of amended Claim 1, from which Claims 9-12 ultimately depend. The Examiner has made no showing as to how the elements in amended Claim 1, which are not taught or suggested by *Shiner* or *Tesch*, were obvious to one of ordinary

Serial Number: 09/717,553  
Attorney Docket No.: 09824.105002  
Page 15

skill in the art at the time of the invention. In the absence of support for the Examiner's assertion of obviousness against pending Claims 3-16, Applicants respectfully request that the Examiner withdraw the present rejection of Claims 9-12 of this application.

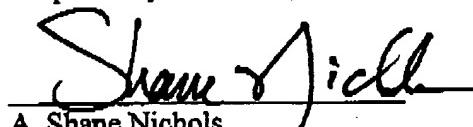
**Claim 19 Objection for Depending From a Rejected Base Claim**

Examiner has objected to Claim 19 as being dependent upon a rejected base claim. Claim 19 depends from independent Claim 1. Applicants, in the above paragraphs, have successfully traversed all rejections to amended independent Claim 1. In view of the foregoing, Applicants respectfully request that the Examiner withdraw the present objection of dependent Claim 19.

**CONCLUSION**

Applicants believe that the Claims 1-2, 4-13, and 16-20 are now in condition for allowance. The Examiner is invited to contact the undersigned at the below listed number to discuss this case, if such discussion would expedite the prosecution of this case.

Respectfully submitted,

  
A. Shane Nichols  
Reg. No. 43,836

KING & SPALDING LLP  
191 Peachtree St.  
Atlanta, GA 30303  
404-572-3507  
404-572-5145 (fax)